

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 12, 2003. At the time of the Office Action, Claims 1-44 were pending in this patent application. The Examiner rejects Claims 1-44. Claims 1, 10, 24, and 38 have been amended to make stylistic changes and to more clearly claim what the inventor believes to be the invention. Claim 4 has been canceled without prejudice or disclaimer. Applicant does not admit that these amendments were made as a result of any cited art. Applicant respectfully requests reconsideration and favorable action in this case.

Consideration of Information Disclosure Statements

Applicant submitted Information Disclosure Statements dated August 30, 2000 and November 12, 2001, which the Examiner has failed to consider entirely. Both IDSs were filed before the mailing of a first Office Action on the merits. With respect to the IDS submitted on November 12, 2001, the Examiner has failed to initial the "T" reference on page 2 of 3. Pursuant to M.P.E.P. § 609, Applicant respectfully requests the Examiner to consider all of the art cited in the IDSs dated August 30, 2000 and November 12, 2001, and in the event a patent issues on this Application, that this art be printed on the face of the issued patent. Furthermore, Applicant respectfully requests a copy of the PTO Form-1449 for the IDSs indicating the Examiner's consideration of the references.

Section 103 Rejection

The Examiner rejects Claims 1, 4, 6-7, 10-11, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,878,401, issued to Joseph ("*Joseph*") in view of Gignac, "Descartes tracks inventory through cyberspace" ("*Gignac*"). Applicant respectfully requests consideration of this rejection of Claims 1, 4, 6-7, 10-11, and 17-20 for the following reasons.

Claim 1 recites, in part, "An online system of locating a consumer product having specific configuration in an enterprise production pipeline and inventory, comprising . . . a locate process operable to receive product configuration data and generate a search request message . . . an inventory database storing product availability data comprising information about products on the order bank, products being produced, products in-transit to distribution

facilities, and products at the distribution facilities . . . and a locate server process operable to receive the search request message . . . and further operable to search the product availability data in the inventory database . . ." The proposed *Joseph-Gignac* combination fails to teach, suggest, or disclose various aspects of Claim 1.

At the outset, Applicant notes that the Examiner's use of *Joseph* is improper because *Joseph* teaches away from certain limitations recited in Claim 1. A prior art reference must be considered in its entirety, including disclosures that teach away from the claimed invention. See M.P.E.P. §§ 2141.02 and 2145(X)(D); see also *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). For example, *Joseph* discloses an "apparatus that displays alternative items for items that are out of stock in a store or the like." (Abstract). In discussing problems with prior art systems – problems which *Joseph* is apparently directed at remedying – *Joseph* discloses that in a shoe store, for example, when a style is selected by a customer in a particular size, the selected pair of shoes is retrieved from a stockroom so that the customer may try the shoes on. (Column 1, Lines 41-44). According to *Joseph*, the productivity of the stockroom personnel is critical in maintaining customer satisfaction in that "*if a customer must wait too long for the desired shoes to be retrieved, the customer may leave.*" (Column 1, Lines 48-51; emphasis added). Furthermore, *Joseph* teaches that "if a selected size of a selected style of shoe is out of stock, an "Alternative Sneaker Selection System is activated." (Column 4, Lines 45-46). *Joseph*, therefore, is limited to retail-based searching to find the selected style and size of a particular shoe or alternative shoe that the store has in stock. Thus, at a minimum, *Joseph* teaches away from an "inventory database storing product availability data comprising information about products on the order bank, products being produced, products in-transit to distribution facilities, and products at the distribution facilities," as recited in part in Claim 1.

The Examiner acknowledges that "*Joseph* fails to teach storing product availability data in the enterprise product pipeline." (Office Action, Page 3). However, the Examiner asserts that the proposed *Joseph-Gignac* combination does teach this limitation. Applicant respectfully traverses the Examiner's position. First, there is no suggestion to combine or modify these references. Second, even if the proposed combination is made, combining

Gignac with *Joseph* would render *Joseph* inoperable for its intended purpose. Third, even if the proposed combination is made, *Gignac* fails to make up for the acknowledged deficiencies of *Joseph*. Each of these arguments is addressed below.

First, the rejection of Claim 1 is improper because the Examiner has not shown the required suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine or modify the cited references. The Examiner states that at the time of Applicant's invention, "it would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of *Joseph* such that to store product availability data from a variety of distribution chain nodes in the inventory database." (Office Action, Page 3). Applicant respectfully submits that the Examiner has not shown the required motivation in *Joseph*, *Gignac*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to combine or modify the cited references. This is particularly true in light of the portions of *Joseph* which teach away from Claim 1 as set forth above. Although Applicant does not necessarily agree that the proposed combination of *Joseph* with *Gignac* is even possible, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, does not provide the required suggestion to combine or modify. Nothing in *Joseph*, *Gignac*, or any other cited reference suggests or motivates the proposed combination or modification, nor has the Examiner provided evidence that suggests the proposed combination or modification.¹ Speculation in hindsight that it would have been obvious to make the proposed combination because the

¹ If "common knowledge" or "well known" art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

proposed combination or modification would be helpful is insufficient under the M.P.E.P.² and governing Federal Circuit case law.³

Second, even assuming that *Gignac* teaches an inventory database "storing product availability data comprising information about products on the order bank, products being produced, products in-transit to distribution facilities, and products at the distribution facilities" (an assertion by the Examiner with which Applicant in no way agrees) and that the proposed combination is made, modifying *Joseph* by combining it with *Gignac* (under these assumptions) would render *Joseph* inoperable for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See M.P.E.P. § 2143.01; see also *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). *Joseph* is limited to either finding a customer a desired shoe in a desired size and style in inventory, or finding the customer an alternative shoe in inventory, so that the customer does not have to "wait too long" and does not leave the store. (See Column 1, Lines 50-51 and Column 4, Lines 42-46). Accordingly, the objective of *Joseph* is to prevent the immediate loss of sales and to increase customer satisfaction. Thus, if *Joseph* is combined with the concept of searching for the desired product in "product availability data comprising information about products on the order bank, products being produced, products in-transit to distribution facilities, and products at the distribution facilities," a

² See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an Applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

customer will have to "wait too long" and may leave the store, defeating the intended purpose stated in *Joseph*.

Third, even assuming for the sake of argument that there is a suggestion or motivation to combine *Joseph* with *Gignac*, *Gignac* still would not disclose the acknowledged deficiencies of *Joseph*. For example, neither *Gignac* nor *Joseph* teaches, suggests, or discloses "an inventory database storing product availability data comprising information about products on the order bank, products being produced, products in-transit to distribution facilities, and products at the distribution facilities," as recited in part in Claim 1. *Gignac* merely teaches an "inventory management" system "for VARs, distributors, and manufacturers to track products as they move through the channel." (*Gignac*, Page 1). The system "proactively monitors an order, identifies whether suppliers are shipping in time, and what the status of the customer's order is as it moves from the supplier to the distributor to the VAR to be configured for a customer." (*Gignac*, Page 1). The objective of the *Gignac* system is to decrease time lags. For example, *Gignac* states that "if the goods arrive before the data tells you its there, well that's self defeating isn't it?" (*Gignac*, Page 1). As such, *Gignac* is limited to an *inventory* management system for the monitoring of orders and those items already produced as they move from the supplier to the distributor in the supply chain. Accordingly, *Gignac*, at a minimum, fails to teach, suggest, or disclose "an inventory database storing product availability data comprising information comprising products *on the order bank, products being produced, products in-transit to distribution facilities, and products at the distribution facilities,*" as recited in part in Claim 1.

For at least the reasons given above, Applicant respectfully requests reconsideration and allowance of Claim 1. Claims 4 and 6-7 depend from Claim 1, which Applicant has shown above to be allowable, and are allowable for at least the same reasons. Thus, Applicant respectfully requests reconsideration and allowance of Claims 4 and 6-7.

Claim 10 recites "searching an inventory database for a product matching the product configuration data, the inventory database containing information about products on the order bank, products in-production, products in-transit, and products in inventory." Thus, for reasons similar to those discussed above with regard to Claim 1, Applicant respectfully

submits that neither *Joseph* nor *Gignac* nor their proposed combination discloses, teaches, or suggests each and every element as set forth in Applicant's Claim 10. Rather, *Joseph* is limited to either finding a customer a desired shoe in a desired size and style in inventory, or finding the customer an alternative shoe in inventory, so that the customer does not have to "wait too long" and does not leave the store. (See Column 1, Lines 50-51 and Column 4, Lines 42-46). Accordingly, the objective of *Joseph* is to prevent the immediate loss of sales and to increase customer satisfaction. *Gignac*, on the other hand, merely discloses an *inventory* management system for the monitoring of orders as they move from the supplier to the distributor in the supply chain and is limited to those items already produced. Accordingly, the proposed *Joseph-Gignac* combination does not disclose, teach, or suggest each and every feature of Applicant's independent Claim 10.

Claims 11 and 17-20 depend from Claim 10, which Applicant has shown above to be allowable, and are allowable for at least the same reasons. Thus, Applicant respectfully requests reconsideration and allowance of Claims 11 and 17-20.

The Examiner rejects Claims 2, 8-9, 12, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Joseph* in views of *Gignac* in further views of U.S. Patent Number 6,167,448 issued to Hemphill et al. ("*Hemphill*"). The Examiner rejects Claims 3, 5, and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over *Joseph* in views of *Gignac* in further views of U.S. Patent Number 6,341,282 issued to Sharpe et al. ("*Sharpe*"). The Examiner also rejects Claims 6 and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over *Joseph* in views of *Gignac* in further view of *Sharpe* and Auto-By-Tel (<http://www.autobytel.com>, 12/12/1997) ("*Auto-By-Tel*").

Dependent Claims 2-3, 5-6, and 8-9 and dependent Claims 12-15 and 21-23 depend upon independent Claims 1 and 10, respectively and are patentable over the proposed combinations of references at least because they include the limitations of their respective base claims and any intervening claims. Because Applicant has shown Claims 1 and 10 to be allowable above, Applicant has not provided detailed arguments with respect to Claims 2-3, 5-6, 8-9, 12-15, and 21-23. However, Applicant remains ready to do so if appropriate.

Applicant respectfully requests reconsideration and allowance of Claims 2-3, 5-6, 8-9, 12-15, and 21-23.

The Examiner rejects Claims 24-44 under 35 U.S.C. § 103(a) for reasons similar to those discussed above with regard to Claims 10-23. Accordingly, the Examiner rejects Claims 24-44 over various combinations of *Joseph*, *Gignac*, *Hemphill*, *Sharpe*, and *Auto-By-Tel*.

Independent Claim 24 recites "searching an inventory database for a vehicle matching the vehicle configuration data, the inventory database containing information about vehicles on the order bank, vehicles in-production, vehicles in-transit, and vehicles in-inventory at the dealerships." Independent Claim 38 recites "sending the search request message to a locate process, the locate process operable to search an inventory database for a vehicle matching the vehicle configuration data, the inventory database containing information about vehicles on the order bank, vehicles in-production, vehicles in-transit, and vehicles in-inventory at the dealerships." Thus, for reasons similar to those discussed above with regard to Claim 10, Applicant respectfully submits that neither *Joseph* nor *Gignac* nor their proposed combination discloses, teaches, or suggests each and every element as set forth in Applicant's independent Claims 24 and 38. Rather, *Joseph* is limited to either finding a customer a desired shoe in a desired size and style in inventory, or finding the customer an alternative shoe in inventory, so that the customer does not have to "wait too long" and does not leave the store. (See Column 1, Lines 50-51 and Column 4, Lines 42-46). Accordingly, the objective of *Joseph* is to prevent the immediate loss of sales and to increase customer satisfaction. *Gignac*, on the other hand, merely discloses an *inventory* management system for the monitoring of orders as they move from the supplier to the distributor in the supply chain and is limited to those items already produced. Accordingly, the proposed *Joseph-Gignac* combination does not disclose, teach, or suggest each and every feature of Applicant's independent Claims 24 and 38.

Dependent Claims 25-37 and 39-44 depend upon independent Claims 24 and 38, respectively and are patentable over the proposed combinations at least because they include the limitations of their respective base claims and any intervening claims. Because Applicant has shown Claims 24 and 38 to be allowable above, Applicant has not provided detailed arguments with respect to Claims 25-37 and 39-44. However, Applicant remains ready to do so if appropriate. Applicant respectfully requests reconsideration and allowance of Claims 25-37 and 39-44.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If there are matters that can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney listed below at the Examiner's convenience.

Although Applicant believes that no fee is due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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